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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,930	08/06/2001	Sanford Redmond	0645-4034US3	8711
23838	7590	07/01/2004	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			NGUYEN, THUKHANH T	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/921,930	<b>Applicant(s)</b> REDMOND, SANFORD	
	<b>Examiner</b> Thu Khanh T. Nguyen	<b>Art Unit</b> 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20 and 25-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 25-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20, 25-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce et al (3,978,705) in view of Sauer (4,130,387).

Pearce et al disclose an apparatus for forming thin sheet material, comprising means for supplying sheet material to the die (col. 5, lines 39-52), punch means having a forming member (86, 90) at the tip of the punch, a female die (34, 64) having a shoulder (66) and a bored hole (106), means (74, 102, 181) for controlling the advancement of the punch means from the first position (Fig. 3) not in contact with the sheet, and a second position (Fig. 4) in which a forming portion of the punch advanced into the female die member, where in the forming portion of the punch could have different forming shapes (col. 6, line 66 to col. 7, line 4), and wherein the means for controlling the advance of the punch includes a punch adjustment mechanism (74, 102, 181) capable of penetrating the punch through the film having a thickness of 0.001 to 0.010 inches and an anvil adjustable stop mechanism (266), wherein the die (34, 64) are spring loaded (58, 60, 159), and wherein the apparatus disclose a first (90) and second (190) punch means for forming and punching the sheet material.

However, Pearce et al fail to disclose means for heating the film, and a fault line forming portion on the punch member.

Sauer teaches an apparatus for thermoforming sheet material, comprising supplying means (90) for supplying of thermoplastic film, heating means (col. 4, line 10-12) for heating the film, a punch means (14) with a fault line forming portion (96), a female die (12) having a shoulder (50) and an accurately bored hole (48) which is aligned with the punch means; wherein the punch means has a first position (Fig. 3) in which it is not in contact with the film, and a second position (Fig. 4) in which it is fully advanced to press the film against the female die.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Pearce et al by providing heating means and a fault forming portion on the punch member as taught by Sauer because the heating means would preheat the sheet material so that the sheet material could be reshaped faster at the die, and the fault line forming portion would be used to form a fault line on the formed product to indicate a cutting mark or a measuring mark.

In regard to the shape of the fault line forming portion and the punch surface, it would have been obvious to one of ordinary skill in the art to change the shape of the fault line forming portion or the forming surface of the punch depending on the desired shape of the product. There is no invention in merely changing the shape or form of an article without changing its function except in a design patent. See *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23 and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to control the advance distance of the punch toward the die by rotating the controlling means (74, 102, 181) a certain degree so that the punches will advance into the die a predetermined distance in according to the thickness of the sheet material. However, the

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advance distance of the punch is the functional limitation and does not determine the patentability of apparatus claims. It has been held that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art. The applicants is required to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re Schreiber, 128 F. 3d 1473, 1478, 44 USPQ 2d, 1432 (Fed. Cir. 1997); See also, In re Spada, 911 F 2d 705, 708, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1977); In re Best, 562 F. 2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and Ex Parte Gray, 10 USPQ 2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 20 and 25-43 have been considered but are moot in view of the new ground(s) of rejection.

Pearce et al disclose an apparatus for reshaping thin sheet material, including means for supply sheet material, a pair of punches having different forming shapes, spring loaded die plates, and means for controlling the advance distance of the punches.

Sauer discloses an apparatus for forming thermoplastic material, comprising means for heating sheet material to facilitate the reshaping process and a fault line forming portion on the punches to form a fault line in the product.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Pearce by providing heating means as taught by Sauer, because plastic sheet needed to be soften before it could be reshaped and the fault line forming portion is to formed a fault line in the product as desired.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 571-272-1136. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN

  
ROBERT DAVIS  
PRIMARY EXAMINER  
GROUP 1800-1707

6/27/07